UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,502	11/21/2003	Takashi Miyakawa	117848	7620

25944 7590 10/06/2005

OLIFF & BERRIDGE, PLC
P.O. BOX 19928
ALEXANDRIA, VA 22320

EXAMINER	
EASHOO, MARK	
ART UNIT	**PAPER NUMBER**
1732	

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/717,502	MIYAKAWA ET AL.	
	Examiner	Art Unit	
	Mark Eashoo, Ph.D.	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) *11-12* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *12/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of claims 1-10 in the reply filed on 19-SEP-2005 is acknowledged. The traversal is on the ground(s) that there is no serious burden on the Office by examining both claim groupings. This is not found persuasive because applicant's argument ignores that process claims are examined based upon recited process steps and not the structural limitations of a product formed. Likewise, a product/article is examined based upon recited structural limitations and not upon the process that makes the product. The examination of structural limitations in process claims, that are not needed to be considered in the same manner as when examining the article/product, places a serious burden on the Office and the public by causing unnecessary expense by essentially providing a free examination of a second/different invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected claim grouping, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 19-SEP-2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Asami et al. (US Pat. 4,851,376).

Asami et al. teaches the claimed process of forming a honeycomb body, comprising: mixing raw materials and reclaimed materials for forming a honeycomb body (2:48-65 and examples); dried reclaimed unfired /green material crushed into pieces of about 50 mm and less by using fine milling (3:40-65 and 8:10-60); and wherein the reclaimed material is substantially the same as the raw material (2:48-65).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any

inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 3-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asami et al. (US Pat. 4,851,376).

Asami et al. teaches the basic claimed process of forming a honeycomb body, comprising: mixing raw materials and reclaimed materials for forming a honeycomb body (2:48-65 and examples); dried reclaimed unfired /green material crushed into pieces of about 50 mm and less by using fine milling (3:40-65 and 8:10-60); and wherein the reclaimed material is substantially the same as the raw material (2:48-65).

Asami et al. does not teach a specific mixture of reclaimed material to raw materials. Asami et al. does teach that an extruded honeycomb body may be formed by a mixture of reclaimed material to raw materials or wholly of reclaimed materials (2:48-65). Official notice is given that optimizing the relative ratios of reclaimed material to raw materials is well known in the molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have optimized the relative ratios of reclaimed material to raw materials through routine experimentation, as commonly practiced in the art, in the process of Asami et al., and would have been motivated to do so in order to provide an economical and stable product.

Asami et al. does not teach a using a specific order of mixing the reclaimed material to raw materials. Official notice is given that mixing the reclaimed material into to raw materials in a continuous process is well known in the molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have mixed the reclaimed material into to raw materials in a continuous process, as commonly practiced in the art, in the process of Asami et al., and would have been motivated to do so in order to reuse reclaimed materials without disrupting the normal processing of raw materials.

Asami et al. does not teach a using a specific type of extruder. Official notice is given that use of either a single screw or twin screw extruder is well known in the ceramic molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have use of either a single screw or twin screw extruder, as commonly practiced in the art, in the process of Asami et al., and would have been motivated to do so in order to sufficient mixing to provide a stable product.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached form PTO-892.

Double Patenting

Claims 1-10 directed to an invention not patentably distinct from claims 1-10 of commonly assigned Application No. 10/932,030. Specifically, the claims teach the claimed process of forming a honeycomb body, comprising: mixing raw materials and reclaimed materials for forming a honeycomb body; dried reclaimed unfired

/green material crushed into pieces of about 50 mm and less by using fine milling; and wherein the reclaimed material is substantially the same as the raw material.

Application No. 10/932,030 does not teach a specific mixture of reclaimed material to raw materials. Application No. 10/932,030 does teach that an extruded honeycomb body may be formed by a mixture of reclaimed material to raw materials or wholly of reclaimed materials (2:48-65). Official notice is given that optimizing the relative ratios of reclaimed material to raw materials is well known in the molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have optimized the relative ratios of reclaimed material to raw materials through routine experimentation, as commonly practiced in the art, in the process of Application No. 10/932,030 and would have been motivated to do so in order to provide an economical and stable product.

Application No. 10/932,030 does not teach a using a specific order of mixing the reclaimed material to raw materials. Official notice is given that mixing the reclaimed material into to raw materials in a continuous process is well known in the molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have mixed the reclaimed material into to raw materials in a continuous process, as commonly practiced in the art, in the process of Application No. 10/932,030, and would have been motivated to do so in order to reuse reclaimed materials without disrupting the normal processing of raw materials.

Application No. 10/932,030 does not teach a using a specific type of extruder. Official notice is given that use of either a single screw or twin screw extruder is well known in the ceramic molding art. At the time of invention a person of ordinary skill in the art would have found it obvious to have use of either a single screw or twin screw extruder, as commonly practiced in the art, in the process of Application No. 10/932,030, and would have been motivated to do so in order to sufficient mixing to provide a stable product.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302). Commonly assigned Application No. 10/932,030, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, *or* name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-10 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/932,030. Although the conflicting claims are not identical, they are not patentably distinct from each other because the same reasons as set forth above regarding Application No. 10/932,030.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Eashoo, Ph.D. whose telephone number is (571) 272-1197. The examiner can normally be reached on 7am-3pm EST, Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark Eashoo, Ph.D.
Primary Examiner
Art Unit 1732

October 2, 2005
me

02/04/05